

## REMARKS/ARGUMENTS

Claims 1, 2, 4 – 14 and 16 – 21 are pending in the application.

The Examiner has raised questions regarding Applicants' non-systemically acting or operating limitation required by independent claims 1 and 12. It is respectfully submitted that an agent that operates systemically enters an animal's blood stream in order for a pest to obtain pesticide by biting the animal and absorbing the pesticide that is contained in the blood of the animal. In contrast, a non-systemically operating pesticide, as required by the claims of the present application, will to a large extent reside on top of the animal's coat of hair (see page 6 of the specification of the present application). As further stated on page 6, starting at line 17, by residing on top of the hair the pesticide is not below the hair and on the skin of the animal, i.e. the pesticide does not operate systemically. Thus, the potential for absorption of the pesticide or active ingredients into the body of the animal is minimized. This is in contradistinction to the prior art, as discussed on page 1 of the specification of the present application, where the pesticide and/or carrier penetrate below the hair of the animal. Thus, as stated on page 3, starting at line 20, of the specification, prior art compositions that operate in this manner operate systemically, in other words, they inherently enter the blood stream of the host animal. To avoid this drawback, as stated at the top of page 5 of the specification of the present application, Applicants' mixture does not operate systemically, in other words relative to the host animal (although the pesticide may act systemically within the pest).

The Examiner has also again questioned the language in, for example, claims 2 and 13 regarding the limitation that the mixture contains “essentially no surfactant”. In this regard, the Examiner’s attention is respectfully directed to page 2 of Applicants’ previous amendment, dated December 20, 2005, in which it was explained that the term “essentially” means that there is at most a trace of surfactant present.

Independent claims 1 and 12 have been further amended to indicate that the carrier or combination of carriers includes an oil-based carrier. Furthermore, claim 1 has been further clarified with regard to the non-systemic action of the pesticide relative to the host animal. Applicants respectfully submit that claims 1 and 12 now clearly define the invention and distinguish these claims over the cited art. However, should the Examiner believe further clarification language is required, claims 1 and 12 could be further amended to indicate that the pesticide or mixture is adapted to act non-systemically relative to a host animal by residing essentially on a coat of hair of the animal.

Prior to discussion of the cited art, Applicants would like to emphasize that the fact that the pesticide acts or operates non-systemically relative to a host animal is a critical limitation of the claims; furthermore, a non-systemic environment is brought about by the claimed viscosity limitation. In other words, due to the specific viscosity range required by Applicants’ claims, the pesticide essentially does not reach the skin, i.e. lays on top of the hair of the animal, and hence cannot become transdermal and thus act systemically, thereby overcoming the drawback of the prior art.

With regard to the objection to the “volatile compound” of claim 19, the possible need for such a compound, namely to make a carrier more flowable under

certain conditions, is discussed on page 8, lines 11 – 18, of the specification. Furthermore, claim 19 requires that the volatile compound be soluble in or miscible with the carrier or combination of carriers. Claim 19 further defines that upon application to an animal, the volatile compound evaporates to such an extent that said absolute or resultant viscosity is obtained. It is respectfully submitted that from all of these limitations, one of skill in the art would readily know what kind of volatile compound would be appropriate. However, should the Examiner continue to object to claim 19, Applicants would reluctantly be willing to delete this claim.

With regard the viscosity limitation defined in newly added claims 20 and 21, support therefor can be found on page 6, line 1, of the specification.

### **CLAIM REJECTIONS – 35 USC § 102**

The Examiner's continued application of the Waldstein patent is not understood. Applicants' claims require that the pesticide act non-systemically relative to a host animal. This is a valid functional limitation pursuant to MPEP 2173.05(g), which indicates that a functional limitation is often used "to define a particular capability or purpose", and that such a functional limitation "must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art". It is respectfully submitted that Waldstein provides absolutely no suggestion for a pesticide, and thus fails to qualify as appropriate art pursuant to MPEP 2131 in that it does not teach every element of the claim, and certainly does not show the identical invention "in as complete detail as is contained in the...claim". Furthermore, the rust inhibitor of

Waldstein is adapted to be applied to a ferrous surface, and not to an animal, as required by Applicants' claims. To emphasize this contrast, the Examiner's attention is respectfully directed, for example, to column 2 of Waldstein, lines 51 – 58.

With regard to Mallis, the Example V-oil carrier cited by the Examiner is for cockroaches, which are not found on animals, but refer to the household use indicated by Mallis. It should be noted that in the only specific application for livestock use given by Mallis, namely in column 3 at line 32, the viscosity indicated actually teaches away from Applicants' viscosity in that it is far lower than Applicants' required viscosity range.

Coffee discloses an electrostatically sprayable insecticidal formulation. It is respectfully submitted that those of skill in the art recognize that an electrostatic application is not suitable for application to animals. It is well known that animals are too sensitive to electrical changes, even changes of less than one or two volts. This is also recognized by Coffee, wherein in claim 1 it is stated that the electrostatically sprayable formulation is suitable "to spray plants". Coffee in no way teaches or suggests a mixture for application on an animal as required by Applicants' claims.

With regard to the Lower reference, the Applicants' research has shown that the cited spinosyns are not soluble in oil; it is for this reason that Lower needs to use silicones. Of course, silicones are not an oil-based carrier, as now required by Applicants' amended claims 1 and 12. Furthermore, the viscosity disclosed by Lower is below Applicants' claimed range.

In view of the foregoing, Applicants respectfully request reconsideration of the allowability of Applicants' claims as amended. In addition, should the Examiner have any further comments or suggestions, the undersigned respectfully requests a

Appl. No. 10/659,840  
Amdt. Dated April 30, 2007  
Reply to Office Action of November 30, 2006

telephone interview in order to discuss any outstanding issues and to expedite placement of the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert - Becker", with a long horizontal flourish extending to the right.

Robert W. Becker, Reg. 26,255  
Attorney for Applicants

ROBERT W. BECKER & ASSOCIATES  
707 State Highway 333, Suite B  
Tijeras, New Mexico 87059

Telephone: 505 286 3511  
Telefax: 505 286 3524

RWB:mac